

- 3 -

REMARKS

Claim 16 now stands rejected under 35 USC 102(b) as being allegedly anticipated by Kramer, United States Patent 3,842,890.

Referring now to United States Patent 3,842,890, hereinafter referred to as Kramer, there is taught a coilable closure device which includes a frame, a guide means and a vertical storage chamber for holding a single sheet of plastic which is vertically coilable upon itself within the storage chamber without the use of a post for storage. Structure is best seen in relation to figure 6 wherein the plastic sheet clearly is coiled upon itself in a tight roll without the need of a post. Referring to the detailed description and the figures the frame 32 is connected into the wall or other opening 33 and may be preassembled or assembled at the site. The frame includes a jamb side 34 and a storage jamb 36. The storage jamb 36 contains a closure member 48 in the form of a single sheet used to close the wall opening. The sheet 48 may be made of any suitable plastic. The thickness of sheet 48 is predetermined to permit the plastic sheet to readily coil about itself. A coiling guide 88 is formed within the storage jamb 36 along the entire vertical inner periphery thereof, which has a curved surface as shown in figure 6, so that the outermost coil of sheet 48 will slide along and be guided by coiling guide 88 to permit smooth coiling of sheet 48 within the storage jamb 36. Since the sheet is self coiling there is no need for the use of a vertical post or otherwise to wind about. In one embodiment reinforcing rods are included with this sheet to permit a minimum thickness of the sheet 48 while yet providing sufficient vertical strength. Clearly the storage jamb is formed on the frame as opposed to being formed with the frame as is the case with Applicant's invention. This is evidenced by the first section of Claim 1 of the Kramer reference set out below.

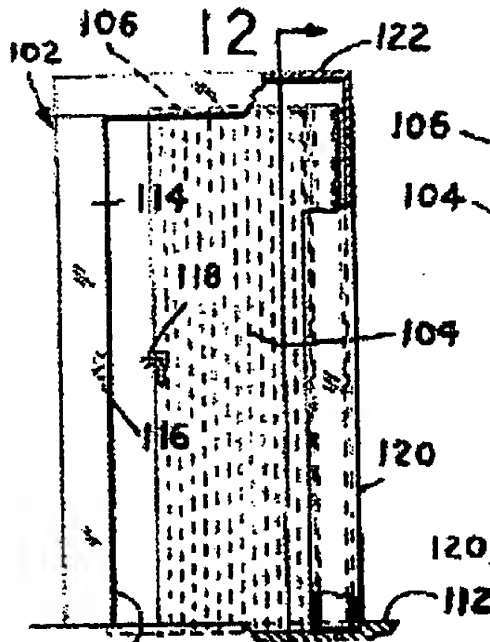
1. A storable closure device for a door opening comprising:

a. a frame connected across the door opening,

- 4 -

b. a storage chamber formed on one side of the frame.

as also seen in the figures and particularly Figure 11:

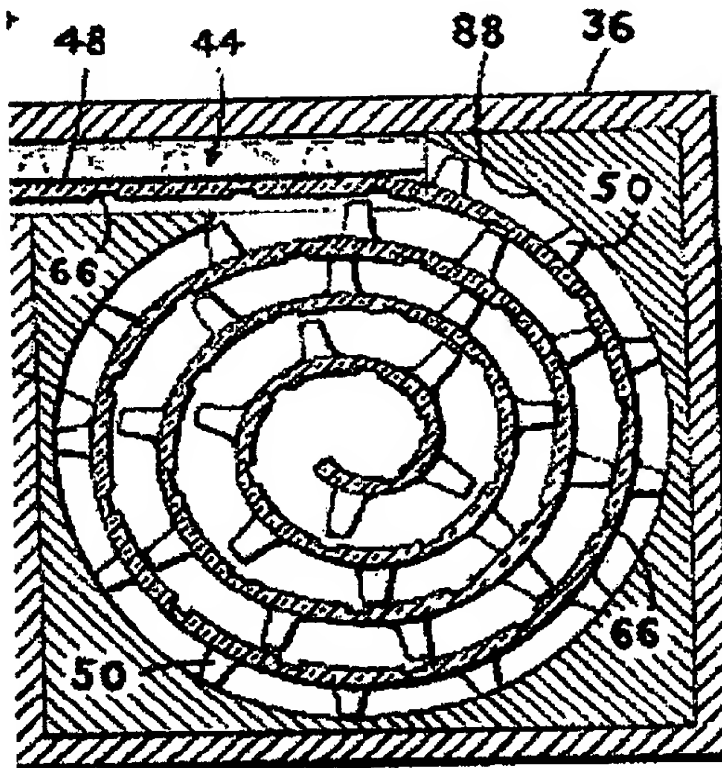


Clearly therefore the purposes of the present invention and that of Kramer are somewhat opposed. Although Kramer may provide a closure it is clearly a plastic sheet serving as a door and not as a screen mesh for the purpose of preventing insects from entering a dwelling. Although the door, one would argue, might prevent insects from entering the dwelling, it is clear it will not allow fresh air to enter the dwelling which would be permitted by the screen utilized with the present invention.

Guides are provided with present invention which extend from the handle portion and are adjustable therein and ride in a track provided in the header and the sill. See claims 2 and 10

- 5 -

in this regard. However these guides do not act as spacers to allow for coiling as is clearly the case with respect to item 50 provided with the plastic sheet 48 as best seen in figure 6 and figure 10.



The spacers 50 space the coils to allow for smooth operation of the Kramer device and eliminate the need for a roll allowing self coiling of the door. The spacers in operation also run in the channels 42/70 provided with the assembly. In contrast the present invention relates to a screen which is very thin whose only purpose is to block insects from entering the dwelling while permitting fresh air to enter therein at the same time.

Therefore the first issue that the Examiner alleges in his action on page 2, that Kramer discloses a closure assembly mounted within an opening comprising a jamb respectfully is not the case. Kramer provides a closure assembly with a jamb pocket mounted on the frame, not formed with the frame. Secondly, the Examiner has stated that Kramer includes

- 6 -

a retractable biased screen. Respectfully the plastic sheet of Kramer is not a biased screen. The retractable plastic sheet of Kramer is a closure that is to say a door and it does not serve a dual purpose of being a screen nor is it analogous to a screen. Kramer's closure is made from heavier plastic and is intended to serve as a door and not intended to serve as a screen at any time nor is there any disclosure within Kramer, Kramer having been carefully read by Applicant's Agent, which would suggest at any time that the heavier plastic door of Kramer might be used or analogous to a screen assembly. First of all Kramer will coil upon itself. Kramer does not include a post or a roll tube to accumulate the door of Kramer. It probably would not accumulate on a roll or a post and therefore the Kramer assembly is post-less unlike Applicant's present invention.

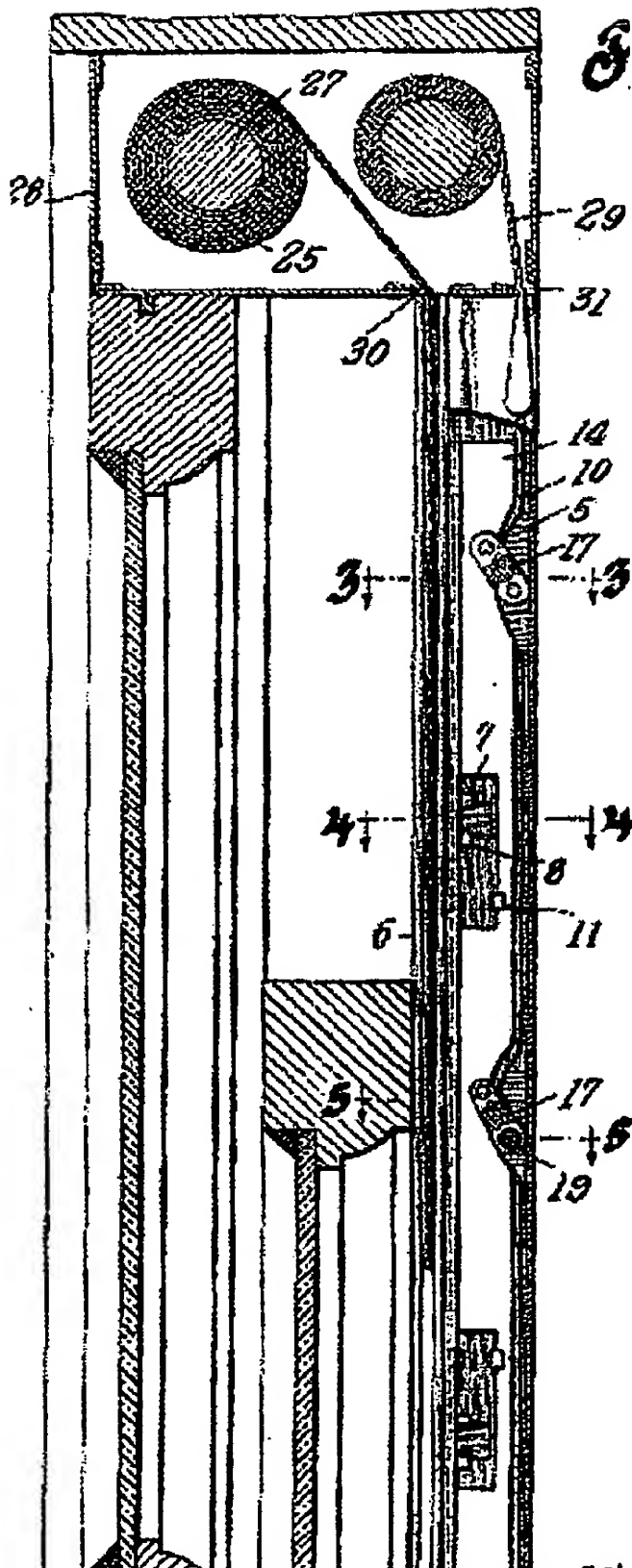
Claim 16 now stands rejected under U. S. C. 102b as being clearly anticipated by Kramer. In view of the discussion above how can Kramer anticipate when Kramer lacks a roll which is now included as a necessary limitation in the amendments to claim 16. Further Kramer is not extruded wherein Applicant's closure assembly is clearly extruded. This extrusion limitation finds support with respect to figures 1D, 15, 15a, 18, 21, 35a, 35b. The Examiner is referred to page 41 of the disclosure for discussion of the construction of figure 1D and to the bottom of page 44 onward with respect with discussion of figures 35a and 35b. It can be clearly seen with respect to these figures and the descriptions related thereto that the sections of the assembly are clearly extrusions. Therefore this limitation has been added to the amended claim 16 and as well as the other amended independent claim 1.

Claim 1, 2 and 10 now stand rejected under 35 U. S. C. 103a as being unpatentable over Kramer in view of Warnick.

- 7 -

Referring now to Warnick U. S. Patent 1,756,496 hereinafter referred to as 'Warnick' there is taught a window screen assembly which in Warnick's words overcome the limitations of the prior art and provide for tight clamping of the side edges of the screen to avoid entrance of any insects around the screen edges. The clamping device is therefore provided and which consists of the lateral movement of a plate 10 as best seen in figure 2 with respect to flange 16 which as a consequence comes into clamping engagement with a flange 6. The side edges of the screen are held between felt strips in and roller 27 carried in box 28.

- 8 -



- 9 -

The question then becomes what advantage can the teaching of Kramer derive from the teachings of Warnick. Clearly there is no motivation in the Kramer reference, which deals primarily with a door made from plastic materials, to even refer to Warnick for any information regarding screening since there is no teaching or motivation regarding screening as an issue in the Kramer reference. The Examiner has clearly attempted to pick and choose from the prior art in order to create a 20/20 hind sight reconstruction.

Warnick discloses a retractable screen within a closure assembly which is a window. The problem being solved by Warnick is the prevention of insects entering around the edges of a screen assembly and therefore clamps the screen in the manner indicated.

So even if Kramer were to be combined with Warnick, which the Applicant suggests is not possible since they are mutually exclusive, what would the end construction be? Applicant asserts that the end result would be a screen assembly of Warnick disposed over the door assembly of Kramer which would still not result in Applicant's simplified construction and the combination would require a separate pocket for the door of Kramer and a separate pocket for the screen assembly of Warnick in order to combine the two constructions in an operable manner.

Clearly the construction of Kramer will not work as a window. The plastic construction including the spines and the interconnected sections just would be not be compatible or desirable for a window construction. Further even if Warnick were to be combined with Kramer it would be required that a separate box be provided for the screen assembly of Warnick as it could not be integrated into the construction of Kramer. The Kramer portion jamb pocket is necessary to allow for the paying out of the door of Kramer. Kramer is just not a screen assembly. Therefore how can one skilled in the art combine the teachings of Kramer and Warnick absent the teaching or motivation in Kramer that it would

- 10 -

be desirable to provide a screen assembly in a similar construction to the door assembly of Kramer.

On the other hand Applicant's invention fits within the envelope provided by the window assembly. No additional width is required for the frame should screen assembly be present in the pocket of the jamb frame section or not. The resulting width would be identical so therefore no additional bulk is added to Applicant's invention as result of integrating a screen assembly in the jamb section and in the preferred embodiment the width is still 3 and 1/4 inches. Further no additional labour is required at the site when the window is being installed with the integral jamb pocket. It is only necessary to place the screen assembly in the jamb pocket after the window is installed. It is not necessary therefore with the Applicant's invention to provide an additional box added to the frames as is the case with Kramer. This box construction of Kramer is built onto the frame either on site or off property regardless requiring extra labour as opposed to Applicant's invention wherein the pocket is formed when the jamb section is manufactured by extrusion. Applicant's invention is therefore a dual function frame section which is manufactured by extrusion in a quicker manner resulting in improved economics and better performance through the window assembly.

Further there is no coil guide required with Applicant's structure which is therefore eliminated and the result is more aesthetically pleasing since the bulk to accommodate the door of the Kramer is eliminated. Applicant's invention fits within the envelope provided.

It is therefore respectfully requested for the reasons set out above and in view of the amendments of Applicant's claim that the Examiner withdraw the prior art references cited and allow the claims as amended.

- 11 -

Applicant however has provided a window assembly including an integral jamb and jamb pocket manufactured as an integral unit by an extrusion process as defined in the amended claim 1 as follows:

A window assembly comprising, a jamb having an interior, defining a jamb pocket portion and a retractable screen disposed with a screen cassette contained within the jamb pocket portion integral with the jamb of the assembly, said jamb and said jamb pocket portion being manufactured by an extrusion process as an integral unit when the window assembly is formed, said jamb pocket portion being defined by three sides of the interior of said jamb, the screen accumulating on and paying out from a spring biased roll provided with said cassette disposed within said jamb pocket portion.

The prior art cited Kramer and Kramer in view of Warnick do not contain the limitations as provided in the above mentioned claim.

United States Patent Number 3,842,890, Kramer teaches a coilable closure device to open or close a door opening. The device includes a frame, a guide means, a vertical storage chamber and a single sheet of plastic vertically coilable upon itself within the storage chamber without the use of a post for storage when not in use. Whenever the door opening is to be closed the sheet is slid in the guide means across the frame. The guide means are either fixed or pivotal and the top of the plastic sheet can be horizontal or slanted.

United States Patent Number 1,756,496 to Warnick teaches a device for clamping the side edges of a window screen comprising a stationary plate provided with a flange, a link pivoted on said stationary plate, means pivotally connected with said link to bear against the movable plate to cause the latter to move laterally when said link is rotated.

- 12 -

The following excerpts of U.S. case law represent Applicant's understanding of the test for novelty and obviousness.

In Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986) ("It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention, and that such a determination is one of fact.").

In re Donohue, 766 F.2d 531, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985) ("an anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice, or device.").

In Atlas Powder Co. v. E.I. du Pont De Nemours & Co., 750 F.2d 1569, 1574, 224 U.S.P.Q. 209, 411 (Fed. Cir. 1984) ("exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference").

In Tights, Inc. v. Acme-McCrory Corp., 541 F.2d 1047, 191 U.S.P.Q. 305 (4th Cir. 1976); Saf-Gard Prods., Inc. v. Service Parts, Inc., 532 F.2d 1266, 190 U.S.P.Q. 455 (9th Cir. 1976); Shanklin Corp. v. Springfield Photo Mount Co., 521 F.2d 609, 187 U.S.P.Q. 129 (1st Cir. 1975) ("To anticipate under section 102, a prior art reference must disclose all the elements of the claimed invention or their equivalents functioning in essentially the same way.").

In re Beno (1985) 768 F.2d 1340, 226 U.S.P.Q. 683 (Fed. Cir. 1985) a prior art patent or published application is a reference only for that which it teaches.

OBVIOUSNESS

The traditional test enunciated in Graham vs. John Deere Company 383 U.S. 1, 148 U.S.P.Q. 459 1966, for Section 103 nonobviousness requires the fact finder to make several determinations. The test provides that the scope and content of the prior art be determined, the differences between the prior art and the claims at issue be ascertained, and the level of ordinary skill in the pertinent art be resolved. Thus, the patentability of the claims at hand must stem from the fact that the specific combination of the claimed elements was not disclosed in the prior art and the additional allegation that the specific combination of claimed elements was nonobvious to one of ordinary skill in the art.

Clearly, the prior art does not suggest or provide any reason or motivation to make such a modification as purported by the Examiner. With reference to In Re: Regal, 526 F. 2d 1399, 1403 n. 6, 188 USPQ 136, 139 n. 6 (CCPA 1975).

"There must be some logical reason apparent from positive, concrete evidence of record which justifies a combination of primary and secondary references".

In Re: Geiger, 815 F. 2d 686, 688, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987) (obviousness can not be established by combining pieces of prior art absent some "teachings, suggestion, or incentive supporting the combination"); In Re: Cho, 813 F. 2d 378, 382, 1 USPQ 2d 1662, 1664 (Fed. Cir. 1987) ("discussing the Board's holding that the artisan would have been motivated to combine the references").

- 13 -

Therefore, it Applicant's view there is no evidence of motivation in the prior art, either within the references themselves, or knowledge generally available to one of ordinary skill in the art, to make the purported changes suggested by the Examiner to arrive at the claimed subject matter.

Respectfully, the Examiner is creating a 20/20 hindsight reconstruction using Applicant's invention as a blue print to allegedly find elements of Applicant's combination in the prior art. This is not permissible as set out below.

In re Oetiker, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992)

The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. (emphasis added) That knowledge can not come from the applicant's invention itself.

ATD Corporation v. Lydall, Inc., 48 USPQ 2d 1321, 1329 (Fed. Cir. 1998)

Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor. (emphasis added)

In Re: Fritch, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992)

"Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board. Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious(emphasis added). The court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In Re: Rouffet, 47 U.S.P.Q. 2d 1453 (Fed. Cir. 1998)

"As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art.

- 14 -

*If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).*

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. (emphasis added)

This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. In this case, the Board relied upon none of these. Rather, just as it relied on this high level of skill in the art to overcome the differences between the claimed invention and the selected elements in the references, it relied upon the high level of skill in the art to provide the necessary motivation. The Board did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Instead, the Board merely invoked the high level of skill in the field of art. If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

*Because the Board did not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of Rouffet's invention to make the combination, this court infers that the examiner selected these references with the assistance of hindsight. This court forbids the use of hindsight in the selection of references that comprise the case of obviousness. (emphasis added) See *In re Gorman*, 933 F.2d 982, 986, 18 USPQ 2d 1885, 1888 (Fed. Cir. 1991). Lacking a motivation to combine references, the Board did not show a proper prima facie case of obviousness. This court reverses the rejection over the combination of King, Rosen and Ruddy."*

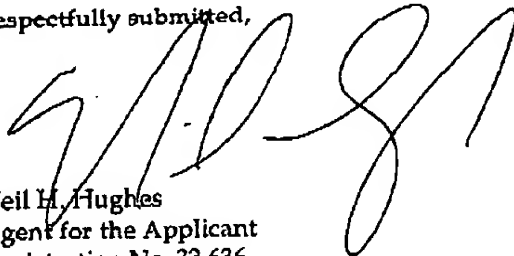
It is axiomatic for a reference to anticipate that it must meet every limitation of the claims. This is clearly not the case with Kramer. Nor would Kramer in view of Warnick

- 15 -

render obvious claim 1 or claim 16 in that one skilled in the art would not be motivated directly or indirectly to arrive at Applicant's invention identified in claim 1 or claim 16 from a fair reading of Kramer and Warnick as set out in detail above. Full reconsideration is respectfully requested.

If the Examiner has any questions, the Examiner is respectfully requested to contact Neil H. Hughes at (905) 771-6414 at his convenience.

Respectfully submitted,



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NHH:jlh
Attachments